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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/752,700

01/08/2004

Kazuyuki Kuwada

Q79277

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65565 7590 05/13/2009  
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EXAMINER

SUCH, MATTHEW W

ART UNIT

PAPER NUMBER

2891

MAIL DATE

DELIVERY MODE

05/13/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/752,700	<b>Applicant(s)</b> KUWADA ET AL.	
	<b>Examiner</b> MATTHEW W. SUCH	<b>Art Unit</b> 2891	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 3-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Specification***

1. The amendment filed 16 January 2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The entirety of the specification amendment filed on 16 January 2009 is new matter. Applicant is required to cancel the new matter in the reply to this Office Action. The attempt to incorporate subject matter into this application by reference to JIS Z 0237 is ineffective for at least the following reasons. Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. *In re de Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). The specification as originally filed fails to provide a clear intent to incorporate the subject matter by using the words "incorporate(e)" and "reference". See MPEP § 608.01(p) and MPEP § 2163.07(b). See also 37 C.F.R. 1.57 for requirements. The specification as originally filed merely uses the phrase "as provided for in JIS Z 0237" (see Page 6, Lines 22-23). The subject matter relied upon by the Applicant and amended into the specification is essential subject matter as set forth under 37 C.F.R. 1.57(c) since it is used to describe the claimed invention and the JIS Z 0237 appears to be a foreign document. An incorporation by reference of essential subject matter to an unpublished U.S. patent application, a foreign application or patent or to a publication is improper under 37 C.F.R. 1.57(c). See MPEP 608.01(p). Applicant is required to

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amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. See 37 C.F.R.

1.57(f). The Applicant has not provided the Office with a copy of JIS Z 0237 along with a translation (Applicant notes in the Remarks that a copy has been submitted along with a translation). See 37 C.F.R. 1.57(e). As such, there is no evidence on record that the text added into the specification is identical to the JIS Z 0237 document and includes any essentially subject matter required for completeness. A copy of the incorporated material may be required is where the material is being inserted by amendment into the body of the application to replace an improper incorporation by reference statement so that the Office can determine that the material being added by amendment in lieu of the incorporation is the same material as was attempted to be incorporated. See MPEP § 608.01(p). The Applicant footnotes (Remarks, page 7) that the designation is the "latest revision in the year 2000", however the originally filed specification is silent regard which revision Applicant is intends to use and there is no evidence on the record of what the change history is to this revision and if there are any other or more recent revisions to the method which may change the scope of the disclosed subject matter. The text amended into the specification includes further relies upon additional documents of JIS C 2318, JIS G 4805 and JIS B 1501 which appear to define critical elements of the invention since they appear to be required for completeness. The Applicant has not provided the Office with copies of these documents along with translations. See 37 C.F.R. 1.57(e). The subject matter in the documents

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JIS C 2318, JIS G 4805 and JIS B 1501 included by the amended into the specification is essential subject matter as set forth under 37 C.F.R. 1.57(c) since it is used to describe the claimed invention and each appears to be a foreign document (see above). An incorporation by reference of essential subject matter to an unpublished U.S. patent application, a foreign application or patent or to a publication is improper under 37 C.F.R. 1.57(c). See MPEP 608.01(p). Additionally, it is unknown which revision number (if any) and what the change history of JIS C 2318, JIS G 4805 and JIS B 1501 are which may change the scope of the disclosed subject matter.

### ***Drawings***

2. The drawings submitted with the specification amendment are objected to because Fig. 7 is included in the specification and must be provided on a separate sheet. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR

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1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-2 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 2 recite "in terms of ball tack obtained by the ball rolling method provided for in JIS Z 0237". However, this renders the claims indefinite for several reasons. The Applicant has not provided the Office with any documentation of exactly what this testing standard is, and as such, it is unknown how the ball tack numbers are obtained. It is further unknown what revision number (if any) the Applicant is referring to. Additionally, a recitation referencing an external document standard (such as JIS Z 0237) in a claim as a limitation further renders the claim indefinite because and there is no way of knowing that such a standard will be consistent in the future and remain unchanged. As such, results from the JIS Z 0237 test as currently written may be different some time in the future under an alteration or revision of the testing procedure and may not be representative of the same material property value in the future under such changes. Therefore, the scope of the claimed invention may or may not change in the future and there is simply no way of predicting the future. Furthermore,

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there is also no way of knowing whether JIS policy related to the maintaining numbering conventions, rules on revision numbers and test numbers, or any other identifying marks to this procedure will remain completely unchanged in the future. Unforeseeable circumstances or changes may occur at any time to JIS policy or testing standards or identifying nomenclature, even if there is no history of such changes until the present. As such, it is unknown that the scope of the claim would remain consistent and the public may be unable to identify if and when any infringement may or may not occur. Therefore, the claim is indefinite.

### ***Response to Arguments***

5. Applicant's arguments filed 16 January 2009 have been fully considered but they are not persuasive.

The Applicant argues that claims the claims are not indefinite on the grounds that the specification has been amended to include the subject matter of JIS Z 0237 and that other US patents have been issued with JIS standards recited in the claims. These arguments are not persuasive for at least the following reasons. The subject matter added to the specification in regards to JIS Z 0237 is new matter as set forth above and does not clarify the indefiniteness of the claims as written. Furthermore, it is unclear which US patent documents the Applicant is referencing and how these documents clarify the indefiniteness of the subject matter claimed in the present application.

The Applicant states that a copy of JIS Z 0237 and a sworn English translation has been included. However, no such documentation has been provided to the Office.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Contact Information***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW W. SUCH whose telephone number is (571)272-8895. The examiner can normally be reached on Monday - Friday 9AM-5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kiesha Rose can be reached on (571) 272-1844. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew W. Such/  
Examiner, Art Unit 2891

MWS  
5/8/09

/Douglas M Menz/  
Primary Examiner, Art Unit 2891  
5/8/09